

**REMARKS**

The above amendments and following remarks are provided in response to the office action mailed December 17, 2004.

Applicant acknowledges with gratitude the indication of allowable subject matter.

Applicant has reviewed carefully the instant Office Action, and the applied publication of Druckenmiller et al.

In light of this careful review, Applicant respectfully traverses the rejection raised under 35 USC §102(e) of claims 1, 3-6, 12 and 15-20 as being anticipated by Druckenmiller.

Specifically, claim 1 recites the steps of attaching contact information to an email having a recipient's email address, associating a transaction ID with the contact information, and associating a first hash of the recipient's email address with the transaction ID.

For a rejection to be made under 35 USC §102(e) the claimed subject matter must be described in the relied upon patent and each and every limitation of the claim must be described in that relied upon patent.

Druckenmiller fails to describe any method or system that attaches contact information to an email having a recipient's email address, associates a transaction ID with the contact information, and associates a first hash of the recipient's email address with the transaction ID. Yet this is subject matter explicitly recited in claim 1.

In making the rejection under Druckenmiller, the Office Action asserts that this claimed subject matter is described in Druckenmiller and specifically references column 2, lines 62-65 and column 2, lines 6-8; column 3, lines 22-24. This assertion is incorrect. Druckenmiller lacks any description or teaching of associating a transaction ID with contact information, and associating a first hash of the recipient's email address with the transaction ID.

Druckenmiller teaches that a subscriber email address may be used to direct messages through a network to a particular subscriber, and the instant action relies on the teaching at column 2, lines 62-65, as describing a step of attaching contact information (direct messages) to an email having a recipient's email address (email address used to direct messages to a particular subscriber). The office action also asserts that Druckenmiller, particularly at column 2, lines 6-8 and column 3, lines 22-24, describes associating a transaction ID with the contact information (direct messages). Applicant respectfully disagrees. There is no description in Druckenmiller of associating a transaction ID – or any identifier – with the direct messages being sent to the subscriber. Druckenmiller only describes one token. That token, as pointed out in the Office Action, is a token generated from the email address of the subscriber, and associated with that email address. In fact, this is expressly the language that was cited by the examiner:

“Once a subscription request is received, a unique alphanumeric token is generated and associated with the email address.”

Column 2, line 6-8; and

“As discussed in more detail below, once a subscription request is received by the primary system 12, a unique token is generated and associated with the email address.”

Column 3, lines 22-24.

Thus, Druckenmiller teach a token that is generated and associated with an email address, not the contact information being attached to the email.

Druckenmiller describes no other token or ID. Thus, there is no teaching or description in Druckenmiller of a transaction ID that is associated with the contact information being attached to the email. There is only one token described, but the Office Action seems to try to have it both ways, to say the token represents the hash of the email address, as well as the transaction ID. This is not true. There is no transaction ID associated with contact information described in Druckenmiller. The absence of such a transaction ID that is associated with contact information is made clear by column 5, lines 40-54, that teaches that Druckenmiller lacks any transaction ID associated with the contact information and must scan the database to locate a record that contains the token associated with the email. If a transaction ID associated with the

contact information was available to Druckenmiller, they could use that transaction ID to access the contact information, rather than have to scan or search through the database for a token that is associated with a subscriber.

Moreover, there is no description of a step of comparing a second hash of a recipient's email address and a transmitted transaction ID, to determine whether to forward contact information (direct messages) to a recipient.

Druckenmiller only describes one type of token and this token is associated with the email address of the subscriber. The system in Druckenmiller uses this token to determine which mailing lists a subscriber has joined. Druckenmiller does not teach a transaction ID that is associated with contact information or the direct message, and certainly fails to teach any system or method that transmits a transaction ID, and a hash of a recipient's email to a recipient.

As such, Druckenmiller fails to anticipate each element of the claimed subject matter and this subject matter is included in independent claims 1, 15 and 17.

Applicant further traverses the rejection of claims 2 and 9-11 as obvious in light of Druckenmiller and Creswell. First for the reasons stated above, Druckenmiller do not teach all the limitations of claim 1. Secondly, nothing in Creswell bridges the gap between Druckenmiller and the invention recited in claim 1. Nor does Creswell bridge the gap between Druckenmiller and claims 2 and 9-11. Druckenmiller teaches an opt-in system for sending email messages. Nothing in Druckenmiller, and the office action admits this, teaches a system that checks to send updated email messages. This is expected because there is no reason to check. The subscriber was either sent the most recent email message or they were not. Regardless of the teachings of Creswell, no one would ever add the check feature of claims 2, and 9-11, because the server in Druckenmiller keeps track of which subscriber has received which email message. Applicant respectfully submits that the proposed combination of Creswell to Druckenmiller – which is a list server – is an improper hindsight reconstruction made in light of Applicant's disclosure

The argument above applies with equal force to the rejection raised against claims 7 and 8 over Druckenmiller in view of Reilly.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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